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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/868,813

02/26/2002

Tracy Ann Willson

14730

6320

7590

03/30/2004

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,813

Applicant(s)

WILLSON ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-19,21,22,24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/6/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Formal Matters

A. Claims 1-25 are pending in the application and were subject to restriction in the Office Action dated 7/24/03. In the Response dated 1/2/04, Applicants elected Group 8, claims 20 and 23. Applicants stated that claims 24 and 25 were not included in the restriction. The Examiner apologizes for this oversight, as, due to the scanning of all incoming documents, these two claims were associated with another document. Regardless, claims 24 and 25 would be in a Group separate from Groups I-IX since the special technical feature of this Group is not the same as the special technical features of Groups I-IX. See the Answer to Traversal below.

2. Answer to Traversal

A. Applicants elected Group XIII with traverse. They argue that Groups I-IX represent one single inventive concept. More specifically, Applicants argue that the present invention uniquely recognizes that the SOCS box in proteins facilitate the presentation of proteins bound to the SOCS box to the ubiquitination and/or proteasomal compartments. Generally, the presentation of proteins to these compartments requires elongin B and/or elongin C. Therefore, the methods and compositions of Groups I-IX are all premised on the above unique discovery. These arguments have been considered, but are not deemed persuasive. Groups I-XIII are all drawn to separate and distinct methods of using the claimed invention. The PCT Rules do not require the search of Groups which require different method steps and reagents for achieving different goals. Therefore, this restriction is deemed proper and is, therefore, made FINAL.

3. Specification

A. Regarding, for example, page 9, line 25 - this application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825. Applicant needs to provide **a computer readable form (CRF)** copy of a "Sequence Listing" which includes all of the sequences that are present in the instant application and encompassed by these rules, **a paper copy** of that "Sequence Listing", **an amendment directing the entry of that paper copy into the specification**, and **a statement that the content of the paper and computer readable copies are the same** and, where applicable, include no new matter, as required by 37 C.F.R. §§

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1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). The instant specification will also need to be **amended** so that it complies with 37 C.F.R. § 1.821(d) which requires a reference to a particular **sequence identifier** (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. For rules interpretation Applicant may call (703) 308-1123. See M.P.E.P. 2422.04.

B. The specification is objected to since, in the Brief Description of the Figures, Figures 1 and 7 should recite "Figures 1A and 1B" and "Figures 7A and 7B" to remain consistent with the Figures.

4. Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "SOCS" is defined on page 6 line 29 as mutants, derivatives, homologs, etc. of SOCS proteins. Therefore, this term is indefinite. Furthermore, SOCS proteins may contain domains other than SH2 domains (page 2, lines 13-16). Therefore, the metes and bounds of the term "SOCS" is not defined.

B. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: an assay which detects the interaction of SOCS and elongin C. It is not clear, for example, if the assay is to detect an indirect interaction of these proteins, or a direct interaction, such as a binding assay where, for example, one or more of the proteins is labeled.

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5. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A. Claims 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamura et al. (Genes and Development). The claims recite methods of identifying antagonists or agonists which modulate protein degradation. The claims read on modulating SOCS degradation. Kamura teach elongin C can increase expression of SOCS protein by inhibiting its degradation. Therefore, Kamura meet the limitation of the claims. The artisan would immediately envision decreasing SOCS expression by promoting its degradation. See the screening method of Figure 7.

6. Conclusion

A. No claim is allowable.

Advisory information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
March 29, 2004


ROBERT LANDSMAN
PATENT EXAMINER